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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/070,621	03/05/2002	Allan S. Frieze	3704-117.1.1.1 US	9170

7590

09/30/2005

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EXAMINER

JASTRZAB, KRISANNE MARIE

ART UNIT

PAPER NUMBER

1744

DATE MAILED: 09/30/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/070,621

Applicant(s)

FRIEZE ET AL.

Examiner

Krisanne Jastrzab

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 11 July 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 21-36, 39-42, 55, 64, 73 and 74 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 21-36, 39-42, 55, 64, 73 and 74 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>09/2005</u> .   | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Specification***

The disclosure is objected to because of the following informalities: the continuing information as amended, on the first page, is incomplete. Reference to the intervening PCT application is required in order to maintain proper, uninterrupted continuity in filing. Correction is required.

Appropriate correction is required.

### ***Information Disclosure Statement***

The information disclosure statement filed 7/11/2005 (and copied 9/16/2005) fails to comply with 37 CFR 1.97(c) because it lacks a statement as specified in 37 CFR 1.97(e). It has been placed in the application file, but the information referred to therein has not been considered. This IDS was not filed prior to mailing of the first office action in this application.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

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1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 21-36, 39-42, 55, 64 and 73-74 are rejected under 35 U.S.C. 103(a) as being unpatentable over Deeds U.S. patent No. 5,524,755 in view of Miller U.S. patent No. 5,384,103, Feldman et al., U.S. patent No. 5,658,529 and both Smith, deceased U.S. patent No. 3,961,111 and Cohen et al., U.S. patent No. 4,532,065.

Deeds teaches substantially the sterilization container as claimed, namely a container having a top and bottom means each having a set of vent holes covered by filter and filter retaining means, the sets of vent holes being offset from each other. The top and bottom are separated from each other by a silicone gasket when interconnected, which intrinsically functions to electrically insulate the two means. See the figures and column 2, lines 20-50.

Miller et al., teach that it is known and expected to construct sterilization container components from anodized aluminum, wherein the container is formed from two, vented, mating halves, and having stackable feet means provided thereon. The container is also provided with tray means therein for receiving articles to be sterilized and both the tray and container are provided with handles to accommodate user manipulation thereof. See column 2, lines 30-55, column 4, lines 1-45 and column 5, lines 58-60.

Feldman et al., teach the known and expected process of subjecting anodized aluminum medical instruments to gas plasma for sterilization thereof, as well as a process for applying the anodized coating such that it is not affected detrimentally by a hydrogen peroxide plasma treatment. See column 1, lines 24-32 and lines 45-51.

It would have been obvious to one of ordinary skill in the art to form the container means of Deeds from anodized aluminum as recognized as conventional by Miller and in a form as in Feldman et al., because it would be resilient even under the environment of plasma sterilization, which is recognized for being a highly reliable sterilization process.

Both Smith and Cohen et al., teach the recognized conventionality of the formation of anodized coatings on aluminum in thicknesses ranging from 0.3 to 0.4 mils, with Smith in fact teaching that naturally occurring anodized layers are formed in thicknesses of 0.2 to 0.6 "micro inches". See Smith column 1, lines 15-20 and lines 39-44. See Cohen et al., column 1, lines 45-51.

It is noted that Miller and Feldman et al., are silent as to the thickness of the anodized coating, however, they clearly disclose that the coatings are thin and both Smith and Cohen et al., teach conventionally recognized thicknesses of such coatings as falling well within the range claimed by applicant. As such, one of ordinary skill in the art clearly would have chosen a conventionally recognized coating thickness and it would have required only routine experimentation to determine those thicknesses optimal for effectiveness in the sterilizing environment without interfering therewith.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 21-36, 39-42, 55, 64 and 73-74 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-28 of U.S. Patent No. 6,589,477 B1 in view of Feldman et al., Smith, deceased and Cohen et al. 6,589,477 claims substantially the invention as presently claimed without, however, reciting the specific thickness of the anodized coating of the aluminum. Feldman et al., clearly teaches anodized coatings formed to withstand plasma

sterilization parameters, and both Smith and Cohen et al., teach conventionally recognized thicknesses of such coatings as falling well within the range claimed by applicant. As such, one of ordinary skill in the art clearly would have chosen a conventionally recognized coating thickness and it would have required only routine experimentation to determine those thicknesses optimal for effectiveness in the sterilizing environment without interfering therewith.

Claims 21-36, 39-42, 55, 64 and 73-74 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 200-285 of copending Application No. 10/295,758. 10/295,758 claims substantially the invention as presently claimed with only minor language differences there between.

This is a provisional obviousness-type double patenting rejection.

### ***Response to Arguments***

Applicant's arguments filed 7/11/2005 have been fully considered but they are not persuasive. Applicant argues that none of the references applied teach or suggest the criticality of the anodized coating thickness, however, the Examiner would maintain that both Miller and Feldman teach thin coatings, and newly applied Smith and Cohen clearly teach that which the art conventionally recognizes as "thin". In view of the clearly taught conventionality of the claimed anodized coating thickness, Applicant's instant invention does not meet a long felt need in the art.

Applicant further argues that Miller fails to teach or suggest that the tray acts to generate or maintain the electric field effect as is the purpose of the anodized aluminum in the instant invention, however, the Examiner would maintain that is no limitation in Applicant's instant claims requiring such.

It is noted that Applicant did not address the outstanding double patenting rejections in the first office action. A response to those rejections is required in the responding to this office action or the response will be held non-responsive.

### ***Conclusion***


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Krisanne Jastrzab whose telephone number is 571-272-1279. The examiner can normally be reached on Mon.-Wed. 6:30am-4:00pm and alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Kim can be reached on 571-272-1142. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Krisanne Jastrzab  
Primary Examiner  
Art Unit 1744

September 27, 2005